

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe the subject matter that Applicant regards as the invention.

Review of the subject application in view of the present amendment/remarks is respectfully requested.

Specification

The Office action objected to the specification as failing to provide proper antecedent basis for the claimed subject matter under 37 CFR 1.75(d)(1) and MPEP § 608.01(o) with regard to the limitation “cooperating means” in claim 4. For at least the following reasons, the Examiner’s objection is respectfully traversed.

The specification discloses that the carriage 5 is rectilinearly displaceable along the guide 1 in the longitudinal direction of the guide 1 and that the displacement of the carriage 5 is carried out with a low roll resistance due to the cooperation between the ball bearings 7 and the grooves 3 (page 3, lines 5-9). The grooves 3, shown in FIG. 2 of the present application, are an example embodiment of the “cooperating means” recited in independent claim 4 and are also specifically recited in dependent claim 5. Such claim language is believed to be a proper way of capturing subject matter and does not lack antecedent basis from the specification.

Claims 4-13 were not treated on the merits because they were not fully understood. It is believed that claims 4-13 are now clearly understood and ready for examination.

Claim Rejections – 35 USC § 112

Claims 4-13 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Office action asserted that the cooperating means

is not disclosed in the specification. For at least the following reasons, the Examiner's rejection is respectfully traversed.

As discussed with respect to the objection above, the specification discloses that the ball bearings 7 and the grooves 3 cooperate. The grooves 3 as an example embodiment of the "cooperating means" and the ball bearings 7 are an example embodiment of the "rotatable means" as recited in claim 4. Furthermore, this is consistent with claim 5 which recites that "the rotatable means (7) are received in the grooves (3)" meaning the two are distinct elements. Therefore, the cooperating means are not rotatable means and the specification enables one skilled in the art to make and/or use this invention.

Claim Rejections – 35 USC § 103

Claims 1-3 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,779,103 to Silvey (hereinafter "Silvey") in view of U.S. Patent No. Sieradzki (hereinafter "Sieradzki"). For at least the following reasons, the Examiner's rejection is respectfully traversed.

With regard to claim 1, the Office action concedes Silvey does not disclose that the rectilinear movement is carried out by rolling contact between a supporting means and a guide. The Office action asserts that this deficiency is resolved by Sieradzki which discloses a grinding disc that is movable from an inactive position to an active position by rolling contact between a supporting means and a guide.

The Office action is correct as to what Silvey and Sieradzki disclose but the present invention is not an obvious combination of the two.

First, Sieradzki relates to the grinding of railway wheels and is not analogous art. A person of ordinary skill in the art would not have considered the field of grinding railway wheels

relevant. Second, wheels 14 and side rails 15 and 17 of Sieradzki cannot be combined with the grinding machine of Silvey because the machine in Sieradzki is restricted to horizontal movement and must rely on a drive mechanism 18 for actuation (column 2, lines 24-29). Contrastingly, in Silvey, the motor carrier 100 is moved upwardly on the slide member 94 by turning the adjusting screw 94 (column 5, lines 43-45). The angle of inclination of the grinding wheel 88 is positioned with its faces inclined downwardly and toward the left of the machine (column 5, lines 12-14) and the angle of inclination is adjustable by pivoting the support member 84 about the bolt 92 (column 5, lines 14-18). In Sieradzki, it is impossible for the wheels 14 and the side rails 15 and 17 to be adjustably inclined because the drive mechanism 18 is fixed to a surface (FIGS. 1-2). Moreover, such an inclination would require the machine of Sieradzki to have a breaking mechanism. Furthermore, the wheels 14 and the side rails 15 and 17 would not operate in a stable manner with an inclination similar to Silvey because the machine could fall off the side rails 15 and 17. Therefore, Silvey and Sieradzki are incompatible and one of ordinary skill in the art with knowledge of these references would not have deemed the present invention obvious.

With regard to claim 3, the Office action concedes that Silvey does not disclose that the manual transfer of the grinding disc from an inactive to an active position generates a clamping of a saw chain. The Office action then asserts that this deficiency is within the skill of an ordinary artisan.

In fact, the prior art discloses nothing more than an adjustable thumb screw 72 through the block 64 which engages the portion 70 to adjust the width of the slot 38 (column 4, lines 47-53 of Silvey). The Office action offers no clue as to how a saw chain can be automatically

clamped or how automating a previously manually operated function is well within the skill of an ordinary artisan. The assertion in the Office action is baseless and conclusory.


In the present application, manual operation of control arm 22 moves wire 31 and urges chain rulers 29 to abut against and clamp drive link 38. It is not necessary to recite a specific structure because claim 3 is a method claim that is properly supported by the description. Since the Office action failed to offer prior art that would render the subject matter obvious, the language of claim 3 is proper as is.

Throughout the 103(a) rejection, it is not explained how a conclusion of obviousness is reached. For example, it is simply stated that "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have modified the Silvey by carrying out the rectilinear movement of the grinding disc by providing rolling contact between a supporting means and a guide, as taught by Sieradzki in order to provide easier movement of the grinding disc." It must be noted that such lack of reasoning is in conflict with the ruling of *KSR v. Teleflex*, 127 S. Ct. 1727 (2007), which states that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP § 2141.

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. ABE1-38244.

Respectfully submitted,
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